

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appeal No. _____

Application No.: 10/072,435
Filing Date: February 8, 2002
Applicants: Shermer et al.
Group Art Unit: 1745
Examiner: Jane J. Rhee
Title: UNIVERSAL ABRASIVE SHEET
Attorney Docket: 0275S-000563

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REPLY BRIEF

In response to the Examiner's Answer mailed September 7, 2006, please consider the remarks set forth herein.

1. COMBINATION OF THE MARTIN ET AL. AND SIMONS REFERENCES FAILS TO RENDER THE INVENTIONS OF CLAIMS 1, 7-11, 13-17, AND 20 OBVIOUS UNDER 35 U.S.C. § 103(a)

The portion of the Examiner's Answer that responds to Appellants' arguments made in support of the reconsideration and withdrawal of the Section 103 rejection of Claims 1, 7-11, 13-17, and 20, which appears to be the first paragraph under the "Response To Argument" section, was lifted verbatim from both the Final Office Action mailed March 15, 2006 and the Advisory Action mailed April 18, 2006. Appellants fully

responded to these arguments in their Appellants' Brief. Therefore, there is no reason for Appellants to again respond to these arguments.

2. COMBINATION OF THE MARTIN ET AL., SIMONS, AND PEARCE REFERENCES FAILS TO RENDER CLAIMS 3, 19, AND 21-23 OBVIOUS UNDER 35 U.S.C. § 103(a)

The portion of the Examiner's Answer that responds to Appellants' arguments made in support of the reconsideration and withdrawal of the Section 103 rejection of Claims 3, 19, and 21-23, which appears to be the second paragraph under the "Response To Argument" section, was lifted verbatim from both the Final Office Action mailed March 15, 2006 and the Advisory Action mailed April 18, 2006. Appellants fully responded to these arguments in their Appellants' Brief. Therefore, there is no reason for Appellants to again respond to these arguments.

3. COMBINATION OF THE MARTIN ET AL., SIMONS, AND PEARCE REFERENCES FAILS TO RENDER CLAIMS 4 AND 44, AS WELL AS CLAIMS 5 AND 23, OBVIOUS

Claims 4 and 22, as well as Claims 5 and 23, stand rejected under Section 103 in light of the combination of the Martin et al., Simons, and Pearce references.

Claims 4 and 22 recite, "wherein said first and second tip configurations have different sizes." Claims 5 and 23 recite, "wherein said first and second tip configurations have different shapes."

The Examiner's Answer alleges that the Section 103 rejection is proper because:

Pearce teaches that segments that define regions of weakened material wherein the sheet is adapted to be separated along two different segments comprise different shape and sizes.

Pearce further discloses that the segments are located around the boarder of the sandpaper (figures 1-3), thus, it would have been obvious to one having ordinary skill in the art at the time applicants invention was made to

provide Martin et al. with the first and second tip configurations having different sizes and different shapes in order to correspond with a plurality of different sanding machines within the size range for that sheet (col. 2 lines 60-62) as taught by Pearce.

Examiner's Answer at 5.

The Martin et al. reference discloses an abrasive sheet having a tip of a single size and shape. The Pearce reference appears to disclose an abrasive sheet with separable circular areas 2 and 2'. The Simons reference, which was not addressed in the Answer, discloses a square piece of sand paper with four corners of the same shape and size. Neither the Martin et al., Pearce, or Simons references disclose or suggest multiple tip configuration of different shapes or sizes as claimed. While Pearce might disclose holes of different shapes or sizes, there is no disclosure or suggestion in Pearce as to how the tips of the Martin et al. reference could be modified to be provided with different shapes and sizes. Therefore, combination of these references fails to render obvious the inventions at Claims 4, 5, 22, and 23.

This Section 103 rejection is improper because it is based on speculation, unfound assumptions, and hindsight reconstruction to fill deficiencies in the factual basis of the rejection. *In re Warner*, 154 U.S.P.Q. at 178. Even if the references could be modified as the Examiner asserts, such modifications are not obvious unless the prior art suggests the desirability of the modification. *In re Mills*, 221 U.S.P.Q. at 1127. The Examiner fails to provide any evidence or explanation as to why and/or how one of ordinary skill in the art would have been motivated to modify, or even could have modified, the teachings of the Martin et al., the Pearce, and the Simons references to arrive at the claimed inventions. Appellants respectfully request reconsideration and withdrawal of the Section 103 rejection of Claims 4, 5, 22, and 23.

4. COMBINATION OF THE MARTIN ET AL., SIMONS, AND PEARCE REFERENCES FAILS TO RENDER CLAIM 6 OBVIOUS

Claim 6 stands rejected under Section 103 in light of the combination of the Martin et al., Simons, and Pearce references. Claim 6 recites, “[t]he abrasive sheet according to Claim 1, wherein said body portion and said tip portion are separated by a second segment defining regions of weakened material.” The sheet further includes “at least one replacement tip portion extending from one of the body portion and the tip portion and defined by a third segment defining regions of weakened material.” As illustrated in Figure 1, the replacement tip portion is provided at 14A and/or 14B.

The Martin et al., Simons, and Pearce references, alone and in combination, fail to suggest the claimed replacement tip.

In support of the Section 103 rejection, the Answer states the following:

since Pearce teaches that it is well known in the art provide second and third segments that define regions of weakened material wherein the sheet is adapted to be separated along two different segments (figure 1 number 2 and 2'), it would have been obvious to one having ordinary skill in the art at the time applicants' invention was made to provide Martin et al. with the sheet material is adapted to be separated along the second segments to separate a first tip portion, having a first tip configuration, from a first body portion having a first body configuration and the sheet material is adapted to be selectively separated along the third segments to separate a second tip portion, having a second tip configuration different from the first configuration from a second body portion having a second body configuration different from the first body configuration in order to correspond with the plurality of different sanding machines within the size range for that sheet (col. 2 lines 60-62).

Examiner's Answer at 6 [*sic*].

The reasoning set forth in the Examiner's Answer fails to set forth a prima facie case as to why Claim 6 is allegedly obvious. In particular, the Answer fails to set forth a prima facie case as to why “at least one replacement tip portion extending from one of the

body portion and the tip portion" is obvious. This Section 103 rejection is improper because it is based on speculation, unfound assumptions, and hindsight reconstruction to fill deficiencies in the factual basis of the rejection. *In re Warner*, 154 U.S.P.Q. at 178.

Even if the references could be modified as the Examiner asserts, such modifications do not arrive at the claimed invention and such modifications are not obvious unless the prior art suggests the desirability of the modification. *In re Mills*, 221 U.S.P.Q. at 1127. The Examiner fails to provide any evidence or explanation as to why and/or how one of ordinary skill in the art would have been motivated to modify, or even could have modified, the teachings of the Martin et al., the Pearce, and the Simons references to arrive at the claimed invention. Appellants respectfully request reconsideration and withdrawal of the Section 103 rejection of Claim 6.

5. Conclusion

In view of the discussion presented herein and in Appellants' Brief, Appellants believe that the pending claims are patentably distinguishable over the art cited by the Examiner. Accordingly, Appellants respectfully request that the Board reverse the final rejection of Claims 1-11 and 13-23.

Respectfully submitted,

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